

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed April 20, 2004. Applicant believes all pending claims are allowable over the references cited by the Examiner. Applicant respectfully provides these remarks. Applicant respectfully requests reconsideration and allowance of Claims 1-13 and 16-37.

**Independent Claims 1, 13, and 23-34 are Allowable Over the
Proposed *Cupps-Hanson-Harrington* Combination**

The Examiner rejects independent Claims 1, 13, and 23-34 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,991,739 to Cupps et al. ("*Cupps*") in view of U.S. Patent No. 4,971,409 to Hanson ("*Hanson*") and in further view of U.S. Patent No. 5,895,454 to Harrington ("*Harrington*").

The Examiner maintains the rejection of Applicant's claims previously set forth in the Office Action mailed September 11, 2003, and responds to Applicant's remarks in the Response mailed February 11, 2004. Accordingly, Applicant reiterates Applicant's remarks in the Response mailed February 11, 2004, and provides the following remarks addressing the Examiner's response to Applicant's previous remarks.

A. The Examiner has Failed to Properly Establish a *Prima Facie* Case of Obviousness With Respect to the Proposed Combination

In the Response mailed February 11, 2004, Applicant noted that the Examiner had merely stated that it would have been obvious to combine *Cupps*, *Hanson*, and *Harrington* with each other as proposed, without demonstrating that *Cupps*, *Hanson*, *Harrington*, or knowledge generally available to a person having ordinary skill in the art at the time of the invention would have provided the required teaching, suggestion, or motivation to combine *Cupps*, *Hanson*, and *Harrington* as proposed. The Examiner responds that,

as should be self evident from the above rejections, the examiner has not "merely stated that at the time the present invention was made it would have been obvious

for one of ordinary skill in the art to combine the teachings of Cupps, Harrington, Hanson and Cotter” as suggested by applicant. Applicant is referred back to the above rejections for the motivations and since applicant is not specific, no further response is believed necessary.

Applicant respectfully disagrees with the Examiner.

With respect to combining *Hanson* with *Cupps*, the Examiner merely states that “it would have been obvious . . . to communicate the real time delivery time to the customer in Cupps prior to the order being placed so that the customer could make a more informed decision.” With respect to combining *Harrington* with *Cupps*, the Examiner merely states:

it would have been obvious . . . to communicate the real time delivery time to the customer in modified Cupps in a manner as disclosed in Harrington so that delivery time could be used by the customer as criteria for determining which food item to order before beginning any transaction.

In each case, the Examiner merely asserts that it would have been obvious to combine *Cupps* with *Hanson* or *Harrington* as proposed to achieve a certain purported result, i.e., enabling a customer to “make a more informed decision” or “use[] [delivery time] as criteria for determining which food item to order before beginning any transaction.” Applicant respectfully submits that, for at least the following reasons, such assertions fail to demonstrate that *Cupps*, *Hanson*, *Harrington*, or knowledge generally available to a person having ordinary skill in the art at the time of the invention would have provided any teaching, suggestion, or motivation to combine the references with each other as proposed and further that a person having ordinary skill in the art at the time of the invention would have reasonably expected the proposed combination to achieve the purported results, as required by the M.P.E.P. and governing Federal Circuit case law.

Nowhere does the Examiner demonstrate, with respect to either proposed combination, that *Cupps*, *Hanson*, *Harrington*, or knowledge generally available to a person having ordinary skill in the art at the time of the invention would have provided any teaching, suggestion, or motivation whatsoever to make the proposed combination. As an example, the Examiner merely asserts that combining the system of *Hanson* with the system of *Cupps* would have enabled the

system of *Cupps* to “communicate the real time delivery time to the customer . . . prior to the ordered being placed,” without even attempting to demonstrate that such a teaching, suggestion, or motivation can be found in *Cupps*, *Hanson*, or knowledge generally available to a person having ordinary skill in the art at the time of the invention. As another example, the Examiner merely asserts that combining the system of *Harrington* with the system of *Cupps* would have enabled the system of *Cupps* to “communicate the real time delivery time to the customer . . . so that delivery time could be used by the customer as criteria for determining which food item to order before beginning any transaction,” without even attempting to demonstrate that such a teaching, suggestion, or motivation can be found in *Cupps*, *Harrington*, or knowledge generally available to a person having ordinary skill in the art at the time of the invention. If the Examiner intends to assert that a teaching, suggestion, or motivation to combine *Cupps* and *Hanson* or *Cupps* and *Harrington* could have been found in information generally available to a person having ordinary skill in the art at the time of the invention, Applicant respectfully requests that the Examiner provide documentary evidence that such information was in fact generally available to a person having ordinary skill in the art at the time of the invention, as required by the M.P.E.P. and governing Federal Circuit case law.

Moreover, nowhere does the Examiner demonstrate that a person having ordinary skill in the art at the time of the invention would have reasonably expected the proposed combinations to achieve the purported results. First, nowhere does the Examiner demonstrate that the proposed combinations would have in fact produced the purported results. As an example, nowhere does the Examiner even attempt to demonstrate that combining the system of *Hanson* with the system of *Cupps* would have actually enabled the system of *Cupps* to “communicate the real time delivery time to the customer . . . prior to the ordered being placed.” As another example, nowhere does the Examiner even attempt to demonstrate that combining the system of *Harrington* with the system of *Cupps* would have actually enabled the system of *Cupps* to “communicate the real time delivery time to the customer . . . so that delivery time could be used by the customer as criteria for determining which food item to order before beginning any transaction.” Second, even assuming for the sake of argument that the proposed combinations would have produced the purported results, nowhere does the Examiner demonstrate that a

person having ordinary skill in the art at the time of the invention would have reasonably expected such results. As an example, the Examiner merely asserts that combining the system of *Hanson* with the system of *Cupps* would have enabled the system of *Cupps* to “communicate the real time delivery time to the customer . . . prior to the ordered being placed,” without even attempting to demonstrate that a person having ordinary skill in the art at the time of the invention would have reasonably expected such result. As another example, the Examiner merely asserts that combining the system of *Harrington* with the system of *Cupps* would have enabled the system of *Cupps* to “communicate the real time delivery time to the customer . . . so that delivery time could be used by the customer as criteria for determining which food item to order before beginning any transaction,” without even attempting to demonstrate that a person having ordinary skill in the art at the time of the invention would have reasonably expected such result. If the Examiner intends to rely on information that was generally available to a person having ordinary skill in the art at the time of the invention to demonstrate that the purported results of the proposed combinations would have been expected by a person having ordinary skill in the art at the time of the invention, Applicant respectfully requests that the Examiner provide documentary evidence that such information was in fact generally available to a person having ordinary skill in the art at the time of the invention, as required by the M.P.E.P. and governing Federal Circuit case law.

Accordingly, Applicant respectfully maintains that the Examiner has failed to properly establish a *prima facie* case of obviousness with respect to the proposed *Cupps-Hanson-Harrington* combination. Applicant reiterates Applicant’s previous remarks demonstrating that the M.P.E.P. and governing Federal Circuit case law require the Examiner to provide actual evidence of a teaching, suggestion, or motivation for the combination in the prior art. For at least this reason, Applicant respectfully requests reconsideration and allowance of independent Claims 1, 13, and 23-34 and all their dependent claims.

B. The Proposed Combination Fails to Disclose, Teach, or Suggest Limitations Recited in the Independent Claims

In the Response mailed February 11, 2004, Applicant noted that the proposed *Cupps-Hanson-Harrington* combination fails to disclose, teach, or suggest ***one or more databases containing substantially real-time availability information identifying particular food items available from each of a plurality of unaffiliated sellers***, as recited in independent Claims 1, 13, and 23-24. The Examiner responds that “Cupps discloses multiple unaffiliated vendors (108A-108M).” However, even assuming for the sake or argument that the vendors of *Cupps* could be properly considered ***a plurality of unaffiliated sellers***, *Cupps* would still fail to disclose, teach, or suggest ***one or more databases containing substantially real-time availability information identifying particular food items available from each of the vendors***, as recited in independent Claims 1, 13, and 23-24. *Cupps* merely discloses that an online ordering machine retrieves data from an order database and a menu file system to generate a menu web page. Nowhere does *Cupps* disclose, teach, or even suggest that the order database or the menu file system contain any information that is ***substantially real-time***, much less ***substantially real-time availability information identifying particular food items***, as recited in independent Claims 1, 13, and 23-24.

In the Response mailed February 11, 2004, Applicant further noted that the proposed *Cupps-Hanson-Harrington* combination fails to disclose, teach, or suggest ***substantially real-time delivery time information for the unaffiliated seller based at least in part on a current order backlog for the unaffiliated seller***, as recited in independent Claims 1, 13, and 23-24. The Examiner responds that *Cupps* inherently discloses such ***substantially real-time delivery time information*** because, according to the Examiner:

[in *Cupps*,] it is the seller who provides the expected delivery time and therefore in order to provide an expected delivery time it must include any backlog or else the expected delivery time would have no meaning. In other words, it is necessary for the seller to consider any backlog in order to provide an expected delivery time.

(emphasis in original). Applicant respectfully disagrees with the Examiner. Even assuming for the sake of argument that the vendor in *Cupps* provided the expected delivery time, the vendor would not need to ***base the expected delivery time at least in part on a current order backlog for***

the unaffiliated seller, as recited in independent Claims 1, 13, and 23-24. As an example, the vendor in *Cupps* could determine the expected delivery time based solely on a relationship—such as a distance—between a location of the vendor and a location of the customer. According to *Cupps*, the vendor merely “indicate[s] how long the order will take to deliver.” (Column 11, Lines 11-12). It is entirely possible that such an indication would indicate nothing more than a transit time from the location of the vendor to the location of the seller. Nowhere does *Cupps* disclose, teach, or suggest in any way that the vendor indication of “how long the order will take to deliver” is *based at least in part on a current order backlog for the unaffiliated seller*, much less necessarily based at least in part on a current order backlog for the unaffiliated, as inherency requires.

In the Response mailed February 11, 2004, Applicant further noted that the proposed *Cupps-Hanson-Harrington* combination fails to disclose, teach, or suggest *a food order transaction broker operable to generate a list of one or more unaffiliated sellers of the requested particular food item according to a comparison of the requested particular food item with the substantially real-time availability information for each unaffiliated seller*, as recited in independent Claim 1 and in substantially similar form in independent Claims 13 and 23-24. The Examiner responds that *Cupps* discloses a vendor providing a delivery time that, according to the Examiner, is real-time and further that *Harrington* discloses a delivery time based on location that, again according to the Examiner, is real-time. Applicant respectfully submits that, even assuming for the sake of argument that the Examiner were correct, such disclosures would in no way disclose, teach, or suggest *a food order transaction broker operable to generate a list of one or more unaffiliated sellers of the requested particular food item according to a comparison of the requested particular food item with the substantially real-time availability information for each unaffiliated seller*, as recited in independent Claim 1 and in substantially similar form in independent Claims 13 and 23-24.

As discussed above, *Cupps* merely discloses that an online ordering machine retrieves data from an order database and a menu file system—neither of which contain *substantially real-time availability information identifying particular food items*—to generate a menu web page.

Cupps provides the following example: in response to a customer request for pizza, the online ordering machine generates a menu web page showing the first five pizza restaurants that deliver to a location of the customer. (Column 9, Lines 18-20). According to *Cupps*, “the restaurants shown are selected based on the customer’s location and the restaurant’s delivery area.” (Column 9, Lines 20-21). Even assuming for the sake of argument that the menu web page in *Cupps* could be properly considered ***a list of one or more unaffiliated sellers of the requested particular food item***, *Cupps* would still fail to disclose, teach, or even suggest that the online ordering machine in any way ***compares*** the customer request for pizza with any ***substantially real-time availability information identifying particular food items available from each of a plurality of unaffiliated sellers*** to generate the menu web page.

Harrington fails to make up for these deficiencies of *Cupps*. *Harrington* merely discloses a hierarchical or nested menu system guiding a user through a class of available products. (Column 5, Lines 35-40). Nowhere does *Harrington* disclose, teach, or suggest that information on the class of available products in any way includes ***substantially real-time availability information***, as recited in independent Claims 1, 13, and 23-24. In addition, nowhere does *Harrington* disclose, teach, or suggest that the hierarchical or nested menu system ***generates a list of one or more unaffiliated sellers of the requested particular food item***, as recited in independent Claims 1, 13, and 23-24. The Examiner states that, “for something to be hierarchical it must include a comparison to determine the hierarchical order.” However, even assuming for the sake of argument that the hierarchical or nested menu system in *Harrington* includes a comparison, because the hierarchy or nesting of the menu system precedes any user interaction with hierarchical or nested menu system, such comparison necessarily excludes ***a comparison involving the requested particular food item***, as recited in independent Claims 1, 13, and 23-24.

Accordingly, Applicant respectfully maintains that the proposed *Cupps-Hanson-Harrington* combination fails to disclose, teach, or suggest limitations recited in independent Claims 1, 13, and 23-24. For at least this additional reason, Applicant respectfully requests

ATTORNEY DOCKET NO.
020431.0739

PATENT APPLICATION NO.
09/776,130

20

reconsideration and allowance of independent Claims 1, 13, and 23-34 and all their dependent claims.

CONCLUSION


For at least the foregoing reasons, Applicant respectfully requests reconsideration and allowance of all pending claims.

If the Examiner believes a telephone conference would advance prosecution of this Application, the Examiner is invited to contact Christopher W. Kennerly, Attorney for Applicant, at (214) 953-6812.

Applicant believes no fees are due. Nonetheless, the Commissioner is hereby authorized to charge any fee and credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

Baker Botts L.L.P.
Attorneys for Applicant



Christopher W. Kennerly
Reg. No. 40,675

Date: July 20, 2004

Correspondence Address:

Customer Number

05073